

Application No. 10/038,591
Response dated May 6, 2005
In Response to January 13, 2005 Office Action

Remarks

Applicants thank the Examiner for the courtesy extended to their representatives, Jane Gunnison and Shilpa Patel in a February 15, 2005 telephonic interview.

Applicants have cancelled claims 53, 55, 94, 96 and 118, without prejudice. Applicants expressly reserve the right to pursue the cancelled subject matter in one or more subsequent applications that claim priority under 35 U.S.C. § 120 from this application.

Applicants have added claims 151-171 and amended claims 20, 23, 26, 34-46, 48, 50, 54, 56, 57, 122-127, 132, 134 and 135 to improve their form, to conform claim dependencies to the amendments herein and/or to more particularly point out and distinctly claim the subject matter that they wish to prosecute in this application. Support for these claims is found throughout the application.

None of these amendments adds new matter. Upon entry of the amendments, claims 20, 23-27, 29-52, 54, 56-93, 95, 97-117 and 119-171 will be pending. Of those claims, claims 27, 29, 30-32 and 146-150 are pending but withdrawn as being directed to a non-elected invention. Upon a finding that the examined and pending claims are in condition for allowance, applicants request rejoinder of claims 20, 23-26 and 122-145, previously indicated as withdrawn, and of new claims 161, and 168-171.

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Claim Objections

Claims 35 and 121 stand objected to as depending from a rejected claim. Claim 35 depends directly, and claim 121 depends indirectly from claim 34. A finding that claim 34 is in condition for allowance, will obviate the objection to claims 35 and 121.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 34, 53, 55, 57-58, 73, 94, 96-97, 118 and 120 stand rejected under 35 U.S.C. § 112, first paragraph, as not enabled. The Examiner asserts asserts that claims 34, 53, 55 and claims depending therefrom are not commensurate with the scope of enablement disclosed in the specification. The Examiner acknowledges that the specification enables antibodies comprising the CDR sequences of the light chain of antibody 2.13.2 or SEQ ID NO: 6, or of the heavy chain of antibody 2.13.2 or SEQ ID NO: 8 or comprising both the heavy chain and light chain CDRs of said antibody, and also enables an anti-IGF-IR antibody that comprises a heavy chain that utilizes a human DP-47 gene or comprises a light chain that utilizes a human A30 gene. However, the Examiner is of the view that the antibody described in claim 34, to the extent that it includes antibodies “that have CDRs mixed from heavy and light chains” are not enabled.

Claim 34, as amended, is directed to a monoclonal antibody or an antigen-binding portion that specifically binds IGF-IR, comprising the light chain CDR1, CDR2 and CDR3 region amino acid sequence found in the light chain of antibody 2.13.2 or in a light chain comprising the amino acid sequence in SEQ ID NO: 6. The Examiner has acknowledged

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that the application, as filed, in enabling for this subject matter. Accordingly, the rejection of claim 34 and the claims that depend from it should be withdrawn.

Claim 54 stands rejected under 35 U.S.C. § 112, first paragraph, as lacking written description. The Examiner states that the application, as filed, does not refer to a human V_H 3-23 gene. Applicants believe that the Examiner may have overlooked the references to the human V_H 3-23 gene at page 7, lines 22-24, of the specification and in Figure 19B. In view of this disclosure in the application, as filed, the rejection of claim 54 should be withdrawn.

The Examiner also is of the view that the application, as filed, does not teach how to make and use an anti-IGF-IR antibody comprising a heavy chain that utilizes a human DP-47 gene or said gene with at least one of the amino acid substitutions found in SEQ ID NO: 45 or that comprises a light chain that utilizes a human A30 gene or said gene with at least one of the amino acid substitutions found in SEQ ID NO: 47.

Applicants disagree and do not acquiesce in this rejection. However, to expedite prosecution and to permit claims indicated as allowable and claims put in condition for allowance herein to issue, applicants have cancelled claims 53 and 55 as well as claims 94, 96 and 118 which depend from them, without prejudice. Applicants expressly reserve the right to pursue the cancelled subject matter in one or more applications that claim priority under § 120 from this application. Applicants' cancellation of the claims obviates the rejection as to them.

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In view of the foregoing, applicants request withdrawal of the rejections and allowance of the claims.

Respectfully submitted,

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